UNITED STATES PATENT AND TRADEMARK OFFICE

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10/731,974	12/10/2003	Akinori Masushige	1118.68793	9034

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Patrick C. Burns, Esq.
GREER, BURNS & CRAIN, LTD.
Suite 2500
300 South Wacker Dr.
Chicago, IL 60606

EXAMINER
SILVER, DAVID

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

AK

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,6,7,9 and 10* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,6,7,9 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1. The Instant Office Action is in response to a Request for Continued Examination filed 10/10/2007.

2. Claims 1, 3, 6, 7, 9, and 10 are currently pending in Instant Application.

3. The Instant Application is not currently in condition for allowance.

Response to Arguments / Remarks

4. __Applicants argue:__

"Applicants appreciate the indication of allowable subject matter in claims 2 and 4. The independent

claims have been amended to include the allowable subject matter of claims 2 or 4, and allowance is

respectfully requested." **(Remarks: page 9)**

5. __Examiner Response:__

The indicated allowability of claim 2 and 4 is withdrawn in view of the MPEP 2111.04. Rejections based

on the cited reference follow in respective 35 U.S.C. § 102 / 103 section(s).

Upon further consideration, the invention, as currently claimed is not in condition for allowance. The

subject matter that was indicated to be allowable is recited within a "wherein" clause. In accordance

with MPEP 2111.04 which recites:

> Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:
> (A)   " adapted to " or "adapted for " clauses;
> (B)   " wherein " clauses; and
> (C)   " **whereby** " clauses.
> **The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case.** In Hoffer v. Microsoft Corp., 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." Id. However, the court noted (quoting Minton v. Nat 'l Ass 'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby **clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.**'" Id.<

In the Instant Application it is unclear whether the "wherein" clause states a condition that is material to

patentability or simply expresses intended use of the "correcting said GUI" step. MPEP 2111 recites, in

part: "During patent examination, the pending claims must be "given their **broadest reasonable**

interpretation consistent with the specification.""

In view of MPEP 2111 and MPEP 2111.04 the "wherein" are interpreted as intended use and not further

limiting the process. Therefore, although the "wherein" clauses recite subject matter that would be

allowable if recited as a positive process step, they are not given patentable weight and therefore do not

render the claims allowable.

Rephrasing the "wherein" statements into positively recited steps will overcome the interpretation set-

forth above and help place the Application into condition for allowance.

Claim Interpretation

6. Limitations drawn to allowing, enabling or making optional a function's performance does not further

limit a claim. As such, any prior art not explicitly prohibiting the performance of the function

inherently anticipates the limitation.

The "wherein" clauses of all independent claims are not given patentable weight in accordance with

MPEP 2111.04.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 6, 7, 9, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Brooks **(US**

5,831,607).

Brooks discloses: 1. A host terminal emulation program that operates a client computer, a monitor being

connected to the client computer for displaying of screens and to-a communication control unit being

connected to the client computer for transmitting/receiving data to/from a host computer, said emulation

program causing the client computer to perform the steps of:

detecting a coordinate at which a predetermined first attribute is set from coordinates,

characters and attributes in character user interface (CUI) screen data generated in said host

computer when said communication control unit receives CUI screen data from said host

computer **(col: 2 line: 21-24, col: 2 line: 31-38, col: 3 line: 59-61)**;

generating graphical user interface (GUI) screen data in which GUI parts corresponding to said

first attribute are set at respective coordinates following the detected coordinate **(col: 2 line: 45-48)**;

correcting said GUI screen data with reference to the coordinate at which said first attribute is set **(Fig 4A-4C and text which further expands on the features (emphasis on attributes such as Underline (420 "Change"), and bold/reverse color row in the listed table of Subsystem/Jobs/..., col: 5 line: 37-43)**; and

displaying a screen based on the corrected GUI screen data on said monitor **(Fig 1B item 107 / 149, 4A-4C, Fig 1A, and texts which further expand on their features)**,

wherein said GUI screen data is corrected to delete said GUI parts when the coordinate at which said first attribute is set represents the upper left corner of the screen **(Fig 1B, not given patentable weight in view of MPEP 2111.04)**.

Brooks discloses: 3. A host terminal emulation program that operates a client computer, a monitor being connected to the client computer for displaying screens and a communication control unit being connected to the client computer for transmitting/receiving data to/from a host computer, said emulation program causing the client computer to perform the steps of:

detecting a coordinate at which a predetermined first attribute is set from coordinates characters and attributes in character user interface (CUD screen data generated in said host computer when said communication control unit receives CUI screen data from said host computer **(col: 2 line: 21-24, col: 2 line: 31-38, col: 3 line: 59-61)**;

generating graphical user interface (GUI) screen data in which GUI parts corresponding to said first attribute are set at respective coordinates following the coordinate at which said first attribute is set **(col: 2 line: 21-24, col: 2 line: 31-38, col: 3 line: 59-61)**;

detecting a coordinate at which a second attribute corresponding to said first attribute is set from coordinates in said CUI screen data; correcting the GUI screen data with reference to the coordinate at which said second attribute is set when a coordinate at which said second attribute

is detected **(Fig 4A-4C and text which further expands on the features (emphasis on attributes such as Underline (420 Change), and Bold/reverse color row in the listed table of Subsystem/Jobs/..., col: 5 line: 37-43)**; and

displaying a screen based on the corrected GUI screen data on said monitor **(Fig 1B item 107 / 149, 4A-4C, Fig 1A, and texts which further expand on their features)**;

wherein said GUI screen data is corrected to delete said GUI parts when the coordinate at which said first attribute is set represents the upper left corner of the screen **(Fig 1B, not given patentable weight in view of MPEP 2111.04)**.

Brooks discloses: 6. A host terminal emulation method running on a client computer that transmits/receives data to/from a host computer, said emulation method comprising steps of:

detecting a coordinate at which a predetermined first attribute is set from coordinates, characters and attributes in character user interface (CUI) screen data generated in said host computer when CUI screen data is received from said host computer **(col: 2 line: 21-24, col: 2 line: 31-38, col: 3 line: 59-61)**;

generating GUI screen data in which graphical user interface (GUI) parts corresponding to said first attribute are set at respective coordinates following the detected coordinate **(col: 2 line: 21-24, col: 2 line: 31-38, col: 3 line: 59-61, Fig. 4A-4C and their texts which further expand on their features)**;

correcting said GUI screen data with reference to the coordinate at which said first attribute is set **(Fig 4A-4C and text which further expands on the features (emphasis on attributes such as Underline (420 Change), and Bold/reverse color row in the listed table of Subsystem/Jobs/..., col: 5 line: 37-43)**; and

displaying a screen based on the corrected GUI screen data on a monitor **(Fig 1B item 107 / 149, 4A-4C, Fig 1A, and texts which further expand on their features)**;

wherein said GUI screen data is corrected to delete said GUI parts when the coordinate at which

said first attribute is set represents the upper left corner of the screen **(Fig 1B, not given**

patentable weight in view of MPEP 2111.04).

Brooks discloses: 7. A host terminal emulation method running on a client computer that

transmits/receives data to/from a host computer, said emulation method comprising steps of:

detecting a coordinate at which a predetermined first attribute is set from coordinates,

characters and attributes in character user interface (CUI) screen data generated in said host

computer when CUI screen data is received from said host computer **(col: 2 line: 21-24, col: 2**

line: 31-38, col: 3 line: 59-61);

generating graphical user interface (GUI) screen data in which GIA-t parts corresponding to said

first attribute are set at respective coordinates following the coordinate at which said first

attribute is set **(col: 2 line: 21-24, col: 2 line: 31-38, col: 3 line: 59-61)**;

detecting a coordinate at which a second attribute corresponding to said first attribute is set

from coordinates in said CUI screen data; correcting the GUI screen data with reference to the

coordinate at which said second attribute is set when a coordinate at which said second attribute

is detected **(Fig 4A-4C and text which further expands on the features (emphasis on**

attributes such as Underline (420 Change), and Bold/reverse color row in the listed

table of Subsystem/Jobs/..., col: 5 line: 37-43); and

displaying a screen based on the corrected GUI screen data on a monitor **(Fig 1B item 107 /**

149, 4A-4C, Fig 1A, and texts which further expand on their features);

wherein said GUI screen data is corrected to transform said GUI parts when a coordinate at

which said second attribute is detected and a line including the coordinate at which said second

attribute is set is separated three or more lines from the line including the coordinate at which

the first attribute is set **(Fig 1B, not given patentable weight in view of MPEP 2111.04)**.

As per claims 9, and 10, note the rejection of claims 1, and 3 above. The Instant Claims recite

substantially same limitations as the above-rejected claims and therefore rejected under same prior-art

teachings.

Support for Amendments and Newly Added Claims

8. Applicants are respectfully requested, in the event of an amendment to claims or submission of new

claims, that such claims and their limitations be directly mapped to the specification, which provides

support for the subject matter. This will assist in expediting compact prosecution. MPEP 714.02

recites: "Applicant should also specifically point out the support for any amendments made to the

disclosure. See MPEP § 2163.06. An amendment which does not comply with the provisions of 37

CFR 1.121(b), (c), (d), and (h) may be held not fully responsive. See MPEP § 714." **Amendments**

not pointing to <u>specific support</u> in the disclosure may be deemed as not complying with

provisions of 37 C.F.R. 1.131(b), (c), (d), and (h) and therefore held not fully responsive.

Generic statements such as "Applicants believe no new matter has been introduced" may be deemed

insufficient.

Requests for Interview

9. In accordance with 37 CFR 1.133(a)(3), requests for interview must be made in advance.

9.1 Interview requests are to be made by telephone (571-272-8634) call or FAX (571-273-8634).

9.2 Applicants must provide a <u>detailed agenda</u> as to what will be discussed (generic statement such as

"discuss §102 rejection" or "discuss rejections of claims 1-3" may be denied interview).

9.3 The detail agenda along with any proposed amendments is to be written on a PTOL-413A or a

custom form and should be faxed (or emailed, subject to MPEP 713.01.I / MPEP 502.03) to the

Examiner <u>at least 3 days prior</u> to the scheduled interview.

10. Interview requests submitted within amendments may be denied because the Examiner was not

notified, in advance, of the Applicant Initiated Interview Request and due to time constraints may not

be able to review the interview request to prior to the mailing of the next Office Action.
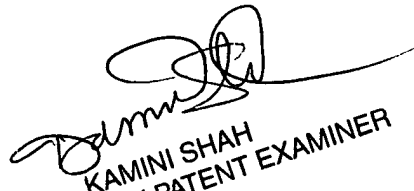
Conclusion

13. All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Silver whose telephone number is (571) 272-8634. The examiner can normally be reached on Monday thru Friday, 10am to 6:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on 571-272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ DAVID SILVER /
David Silver, Patent Examiner
Art Unit 2128

KAMINI SHAH
SUPERVISORY PATENT EXAMINER